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EXAMINER

STERRETT, JONATHAN G

ART UNIT

PAPER NUMBER

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NOTIFICATION DATE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ERIC S. MICHLOWITZ  
And  
ELISA J. SUMNER

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Application No. 09/733,190  
Technology Center 3600

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Mailed: February 6, 2009

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Before PAMELA S. BENNETT, *Review Team Paralegal*.  
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on September 22, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

### **APPEAL BRIEF, GROUNDS OF REJECTION**

Section 1205.02 of the *Manual of Patent Examining Procedure* (MPEP) (Eighth Edition, Rev. 6, September 2007) states, in part:

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review. For example, the statement “Whether claims 1 and 2 are unpatentable would not comply with the rule, while the statements “Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones,” and “Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure would comply with the rule. The statement cannot include any Argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the “Argument” section of the brief.

The “Grounds of rejection to be reviewed on appeal” appearing on page 5 of the Appeal Brief filed February 3, 2008 is defective because, with the exception of the 35 U.S.C. § 101 rejection, a concise statement of the remaining rejections is missing. Correction is required.

### **APPEAL BRIEF, ARGUMENTS**

A review of the file finds that the arguments with respect to each grounds of rejection as provided in the Appeal Brief filed February 3, 2008 under the heading “Argument” has not been clearly provided. Each grounds of rejection must be treated under a **separate heading** in accordance with 37 CFR 41.37(c)(1)(vii). Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a

group should be placed under a subheading identifying the claims by number.

Appellants have not provided the necessary headings and/or subheadings for arguments which correspond to each grounds of rejection. *See also* MPEP § 1205.02 for details.

### **APPEAL BRIEF, EVIDENCE APPENDIX**

MPEP § 1205.02 also states, in part:

*(ix) Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner.

The Evidence Appendix is deficient because it fails to contain copies of the evidence noted on page 5, which was relied upon by appellants in the appeal. Correction is required.

### **CONCLUSION**

Accordingly, it is **ORDERED** that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on February 3, 2008 defective;
- 2) to notify Appellants to file a revised Appeal Brief which corrects the “Grounds of rejection to be reviewed on appeal,” “Argument” and “Evidence Appendix”;

3) for consideration and acknowledgement of the revised Appeal Brief; and

4) for such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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